

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN P. WESSON
and NEIL R. BALDWIN

Appeal No. 2003-1779
Application No. 09/648,016

ON BRIEF

Before KRATZ, JEFFREY SMITH, and POTEATE, Administrative Patent Judges.

KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 13-21. Claims 22-28, which are all of the other claims pending in this application, have been withdrawn from further consideration by the examiner as drawn to a non-elected invention.

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BACKGROUND

Appellants' invention relates to an elevator door assembly including a roller, rail and resilient material track. An understanding of the invention can be derived from a reading of exemplary claim 13, which is reproduced below.

13. An elevator door assembly, comprising:

a rail including at least one supporting surface along at least one side of the rail;

a resilient material track at least partially received by the supporting surface on the rail, the resilient material having a first surface characteristic near at least one end of the track and a second surface characteristic that is different than the first surface characteristic on another portion of the track; and

at least one roller that is adapted to roll along the track.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Spiess	5,655,626	Aug. 12, 1997
Sukale	5,852,897	Dec. 29, 1998

Claims 13 and 16-21 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as their invention. Claims 13-16 and 21 stand rejected under 35 U.S.C. § 102(b) as anticipated by Spiess.

Claims 17, 18 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Spiess. Claim 19 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Spiess in view of Sukale.

We refer to the briefs and the answer for a complete exposition of the opposing viewpoints advanced by appellants and the examiner.

OPINION

Upon consideration of the respective positions advanced by appellants and the examiner with respect to the rejections that are before us for review, we find ourselves in agreement with appellants' position in that the examiner has failed to carry the burden of establishing a prima facie case of indefiniteness, anticipation or obviousness. Accordingly, we will not sustain any of the examiner's stated rejections.

Rejection under 35 U.S.C. § 112, second paragraph

The relevant inquiry under 35 U.S.C. § 112, second paragraph, is whether the claim language, as it would have been interpreted by one of ordinary skill in the art in light of

appellants' specification and the prior art, sets out and circumscribes a particular area with a reasonable degree of precision and particularity. See In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

The examiner's concern is with an alleged ambiguity in appellants' use of the term "surface characteristic." According to the examiner, "it's not understood what Applicants mean by surface characteristic" (final rejection, page 3). The examiner further explains that "it is not clear whether the surface characteristics are different in structural, materials, or frictional" (answer, page 4).

We do not agree that the examiner's expressed concern amounts to a violation of the provisions of the second paragraph of 35 U.S.C. § 112 substantially for the reasons set forth by appellants at pages 5 and 6 of the brief and page 1 of the reply brief. As appellants explained at page 6 of the brief, "a surface characteristic is a trait or quality of the surface that distinguishes it from another." Consequently, we will not sustain the examiner's § 112, second paragraph rejection.

Rejection under 35 U.S.C. § 102(b)

As for the § 102(b) rejection of claims 13 and 16-21 over Spiess, all of the so rejected claims require that a resilient material track that is at least partially received on a rail supporting surface includes a resilient material having a first surface characteristic near at least one end of the track and a second and differing surface characteristic on another portion of the track.

In applying Spiess as an anticipatory reference, the examiner takes the view that the hard and unsprung rest zones (26) depicted in figure 2(c) of Spiess together with the middle unlabeled portion of guide rails 11 and 16 provide first and second surface characteristics.

Appellants (brief, pages 4-6 and reply brief, page 1) argue that the examiner's reliance on the figure 2c embodiment of Spiess is misplaced since that portion of the reference describes a guide rail section that includes a tube or hose-like covering (4) that may include an elastic filling (5, figure 2a) or elastic cushion (17, figure 2b) and does not specify the here claimed surface characteristics.

We agree with appellants that the examiner has not established that Spiess discloses different surface

characteristics at separate locations for the steel sheet or ceramic material covering (4). As set forth at column 4, lines 1-9 of Spiess, the zones (26) of Spiess are described as being unsprung. Based on the evidence before us, the examiner has not fully explained how Spiess expressly or inherently describes a resilient (sprung) material track surface characteristic for the covering (4) at the zones (26) let alone a surface characteristic at a location between the zones (26) that is necessarily different from a surface characteristic of the covering at the zones (26). Consequently, we will not sustain the stated rejection.

Rejections under 35 U.S.C. § 103(a)

Regarding the examiner's § 103(a) rejection of claims 17, 18 and 20 over Spiess and the separate § 103(a) rejection of claim 19 over Spiess in combination with Sukale, we observe that the examiner attempts to address the additional features set forth in those dependent claims but does not persuasively explain how Spiess alone or in combination with Sukale would have suggested the assembly having different resilient material track surface characteristics, a requirement of all of the appealed claims. It follows that we will reverse the examiner's § 103(a) rejections, on this record.

The decision of the examiner to reject claims 13 and 16-21 under 35 U.S.C. § 112, second paragraph, as being indefinite; to reject claims 13-16 and 21 under 35 U.S.C. § 102(b) as anticipated by Spiess; to reject claims 17, 18 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Spiess; and to reject claim 19 under 35 U.S.C. § 103(a) as being unpatentable over Spiess in view of Sukale is reversed.

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